APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,706	02/05/2002	Michael John Curry	1049.001US1	6456

23441   7590   04/10/2009
LAW OFFICES OF MICHAEL DRYJA
1474 N COOPER RD #105-248
GILBERT, AZ 85233

EXAMINER
NGUYEN, VAN H

ART UNIT	PAPER NUMBER
2194	

MAIL DATE	DELIVERY MODE
04/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/683,706	CURRY ET AL.
	Examiner	Art Unit	
	VAN H. NGUYEN	2194	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>02 March 2009</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-11</u> is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-11</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the response to the final office action filed 03/02/2009.

Claims 1-11 are currently pending in this application.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

As to independent Claim 1: the claimed "such that the application program is unaware

that the audio or video program has been integrated therewith" and "such that a user of

the application program is to directly interact with the application program, and the user

is to interact with the audio or video program as though the audio or video program were

part of the application program" are interpreted as the intended use of integrating the

video or video program with the application program. Claim scope is not limited by claim

language that suggests or makes optional but does not require steps to be performed, or

by claim language that does not limit a claim to a particular structure. See MPEP §

2111.04. If applicant intents to limit the scope of the claims with these limitations,

applicant should rewrite the limitations to positively recite the features of the limitations

identified above.

Dependent claims 2-11 are rejected for fully incorporating the deficiencies of their base

claim.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill

in art to recognize "the hardware implements the operating system, the application

program, and the audio or video program" as recited in independent claims 1.

The Examiner could not locate the details of the claimed "the hardware implements the operating system, the application program, and the audio or video program" within the Specification.

Dependent claims 2-11 are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by **Krueger et al**. (US 6460075 B2).

The Krueger reference was cited in the office action mailed on 11/27/2007.

\

As to claim 1:

Krueger teaches a system (see the Abstract and Figs. 1-4) comprising:

> hardware;

> an operating system;

> an application program running on the operating system; and,

> an audio or video program running on the operating system, the audio or video

program separate from but integrated with the application program such that the

application program is unaware that the audio or video program has been integrated

therewith, such that a user of the application program is to directly interact with the

application program, and the user is to interact with the audio or video program as though

the audio or video program were part of the application program, wherein the hardware

implements the operating system, the application program, and the audio or video

program (see Col.1, line 65-Col.2, line 33: *a browser-based email system having a thin*

client connected to a host mail server. The thin client implements a browser. The host

mail server provides pages to the thin client, which can be rendered by the browser to

present an email service to a user. One page contains a mail message screen that allows

a user to construct an email message...the email system allows the thin client to capture

audio and video data for inclusion with the email message... The client browser supports

a user interface that includes pop-up capture panels for both audio and video, with each

capture panel enabling the user to record a selected clip and add the clip to the email

message...After the user has reviewed the email message, the user can click a "Send" link

on the rendered email page to send the email message to an intended recipient. Upon

activation of the "Send" link, the browser submits another request to the host mail server

that contains both the email message and the audio or video data. Upon receiving this

second request, the host mail server converts the email message and the audio or video

data to a MIME (Multipurpose Internet Mail Extensions) message and forwards the

MIME message to the intended recipient, where it can be rendered in full; see Col.7,

lines 53-59: *Although the addition of an audio or video clip involves a round trip*

request/response cycle with the host mail service, this process is hidden to the user. That

is, to the user, the UI experience simply involves capturing the audio/video clip and

hitting the "Add to Message" button. A new screen appears rapidly with the clip attached

to the bottom of the message; see also, Figs.5-9 and the associated text).

As to claim 2:

Krueger teaches the audio or video program is integrated with the application program by

detecting when an event related to the application program occurs (see the Abstract and

Col.1, line 65-Col.2, line 33).

As to claim 3:

Krueger teaches the audio or video program is further integrated with the application

program by subclassing into a window of the application program (see Figs.5-8 and the

associated text).

As to claim 4:

Krueger teaches the audio or video program is further integrated with the application program by hooking into a window of the application program (see Figs.5-8 and the associated text).

As to claim 5:

Krueger teaches the audio or video program is integrated with the application program by employing a customization mechanism of the application program (see Figs.5-8 and the associated text).

As to claim 6:

Krueger teaches the audio or video program is integrated with the application program by employing application programming interfaces of the application program (see Figs.5-8 and the associated text).

As to claim 7:

Krueger teaches the audio or video program modifies contents of a window of the application program created through the operating system (see Figs.5-8 and the associated text).

As to claim 8:

Krueger teaches the audio or video program runs in a window created through the operating system and related to a window of the application program created through the operating system (see Figs.5-8 and the associated text).

As to claim 9:

Krueger teaches the application program comprises, among other things, an email program (*present an email service to a user... allows a user to construct an email message*; see the Abstract and Col.1, line 65-Col.2, line 33).

As to claim 10:

Krueger teaches the audio or video program comprises, among other things, an audio or video recorder program (see Figs.6-7 and the associated text).

As to claim 11:

Krueger teaches the audio or video program comprises, among other things, an audio-and-video program (see Figs.6-7 and the associated text).

Response to Arguments

5.   Applicant's arguments filed 03/02/2009 have been fully considered but they are not

persuasive.

During examination of patent application, a claim is given its broadest reasonable

construction consistent with the specification. In re Prater, 415 F.2d 1393, 1404-05, 162

USPQ 541,550-51 (CCPA 1969). "[T]he words of a claim 'are generally given their

ordinary and customary meaning.'" Phillips v. AWHCorp., 415 F.3d 1303, 1312, 75

USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc) (internal citations omitted). The

"ordinary and customary meaning of a claim term is the meaning that the term would

have to a person of ordinary skill in the art in question at the time of the invention, i.e., as

of the effective filing date of the patent application." Id. at 1313, 75 USPQ2d at 1326.

An intended use of a claimed device does not limit the scope of the claim. In re

Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (product

claim's intended use recitations not given patentable weight); see also Boehringer

Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1345, 65 USPQ2d

1961, 1965 (Fed. Cir. 2003) ("An intended use or purpose usually will not limit the scope

of the claim because such statements usually do no more than define a context in which

the invention operates."). Although "[s]uch statements often.., appear in the claim's

preamble," In re Stencel, 828 F.2d 751,754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987), a

statement of intended use or purpose can appear elsewhere in a claim. Id.

Applicant argued in substance that Krueger does not disclose both an application

program and an audio or video program running on the operating system, where the audio

program is separate from but integrated with the application program such that the

application program is unaware that the audio or video program has been integrated

therewith, and where a user of the application program directly interacts with the

application program and interacts with the audio or video program as though the audio or

video program were part of the application program.

In response, Krueger teaches both an application program (email program; Fig.5) and an

audio (when user clicks on 120 in Fig.5, an audio program is activated, see Fig.6 and

Col.5) or video program (when user clicks on 122 in Fig.5, a video program is activated,

see Fig.7 and Col.5) running on the operating system (the email program, the audio

program, and the video program are running on the operating system of client 22), where

the audio program or video program is separate from but integrated with the application

program such that the application program is unaware that the audio or video program

has been integrated therewith (Figs. 5-7 show the email program, the audio program, and

the video program are separate from but integrated), and where a user of the application

program directly interacts with the application program and interacts with the audio or

video program as though the audio or video program were part of the application program

(Figs.5-7 and Col.5-Col.7 show a user of the email program directly interacts with the

email program, the audio program, and the video program as the audio and video

programs were parts of the email program).

Contact Information

6.   Any inquiry or a general nature or relating to the status of this application should
        be directed to the TC 2100 Group receptionist: (571) 272-2100.

        Any inquiry concerning this communication or earlier communications from the
        examiner should be directed to VAN H. NGUYEN whose telephone number is (571)
        272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM
        6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's
        supervisor, MENG-AI AN can be reached at (571) 272-3756.

        The fax phone number for the organization where this application or proceeding is
        assigned is (571) 273-8300.

        Information regarding the status of an application may be obtained from the Patent
        Application Information Retrieval (PAIR) system. Status information for published
        applications may be obtained from either Private PAIR or Public PAIR. Status
        information for unpublished applications is available through Private PAIR only. For
        more information about the PAIR system, see http://pair-direct.uspto.gov. Should you
        have questions on access to the Private PAIR system, contact the Electronic
        Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a
        USPTO Customer Service Representative or access to the automated information system,
        call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

                                                /VAN H NGUYEN/
                                                Primary Examiner, Art Unit 2194